

REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office Action, and the following remarks are presented for the Examiner's consideration.

The Examiner rejected claims 1 and 3 under 35 U.S.C. 103(a) as being unpatentable over Morita U.S. Pat. App. Pub. No. 2003/0058331 in view of Otsuki U.S. App. Pub. No. 2003/0085937. Applicant respectfully disagrees. Morita does not teach all of the limitations for which it is cited. In particular, Morita fails to teach first and second temperature detection units that detect ambient temperatures of the printer prior to or when performing the printing by the printer in the context of bi-directional printing. Rather, Morita discloses an image recording apparatus in which an image is recorded with an optical beam onto a plate having a photosensitive layer coated thereon. The context or subject matter of bi-directional printing is entirely absent from Morita. In order to compensate for this absence, Otsuki is relied upon for the general disclosure of bi-directional printing. However, neither Otsuki nor Morita provide a suggestion or motivation for the cited combination. Otsuki and Morita involve different subject matter and address different problems. In particular, Otsuki discloses a general configuration for correcting misalignment in the main scanning direction in the course of bi-directional printing and Morita is directed to recording an image onto a photosensitive-coated plate with increased accuracy. It is well established by the Federal Circuit that the combination of elements from non-analogous sources, in a manner that reconstructs the Applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's

invention itself. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985). In this instance, one of ordinary skill in the art would not have been motivated to modify Morita by looking to the teachings of Otsuki due to the non-analogous nature of their subject matter. Moreover, Otsuki fails to disclose, suggest, or provide motivation for the features of the subject application. Therefore, the subject application would not have been obvious in light of the cited combination at the time the invention was made.

The Examiner rejected claim 2 under 35 U.S.C. 103(a) as being unpatentable over Morita U.S. Pat. App. Pub. No. 2003/0058331 as modified by Otsuki U.S. App. Pub. No. 2003/0085937 as applied to claim 1 above and further in view of Silverbrook U.S. Pat. No. 6,802,594 and Silverbrook U.S. Pat. No. 6,464,332. Claim 2 depends from claim 1, thus all arguments presented above with respect to claim 1 apply to claim 2 as well.

The combination of Morita as modified by Otsuki and in view of Silverbrook '594 does not teach "dividing an available temperature range of the printer on the basis of an amount of misalignment at each temperature in such a manner that a temperature subrange larger in the amount of misalignment is narrower than a temperature subrange smaller in the amount of misalignment." More specifically, Silverbrook '594 does not disclose that a temperature range is divided unequally such that the lower temperature subrange is narrower than the higher temperature subrange, and as a result, the unequal divisions of the temperature range allow the accumulated amount of misalignment in one temperature subrange to be substantially equal to that in another temperature subrange. Instead, Silverbrook '594, which is relied upon for this limitation, discloses that a head module

support expands in accordance with the temperature change and thus the alignment between the printing module heads change. Thus, Silverbrook fails to teach the distinct relationship between the temperature subrange divisions and the amount of misalignment as it relates to assigning numbers to each temperature subrange for a temperature subrange table stored by the correction reference value storage unit.

Silverbrook '332 fails to cure the deficiencies of Silverbrook '594 as described above. Therefore, the combination of Morita as modified by Otsuki and in further view of Silverbrook '594 and Silverbrook '332 does not teach all of the limitations of claim 2.

The Examiner made the current Office Action final in view of Applicant's previous claim amendments. The previous claim amendments were made for clarification and did not substantially change the scope of the claims. Newly cited Morita further supports this. According to the Examiner's rejections, Morita was presented to challenge Applicant's previously submitted arguments regarding the temperature detection aspect of the claims, which existed in the claims prior to Applicant's amendment. Hence, withdrawal of the finality is respectfully requested.

In light of the foregoing, it is respectfully submitted that the present application is in condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 36625.

Respectfully submitted,
PEARNE & GORDON, LLP

By: Deborah L. Corpus
Deborah L. Corpus – Reg. No. 47,753

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

Date: September 27, 2006